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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,773	01/13/2000	John D. Dreher	2870/220	7449

26646 7590 08/16/2004

KENYON & KENYON  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER
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YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/482,773

Applicant(s)

DREHER, JOHN D.

Examiner

Gina C. Yu

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED on June 28, 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 28 June 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☒ The proposed amendment(s) will not be entered because:  
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-34.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

  
RUSSELL TRAVERS  
PRIMARY EXAMINER

Continuation from No. 2: the amendment is not entered because the proposed amendment introduces new limitations.

Applicants propose to amend that the method step of applying the composition to lines and wrinkles "associated with aging of" the skin. While this is a new limitation which requires further search and consideration, examiner is also of the opinion that there is no distinction between the population who use the Kimura composition and applicants' invention. Kimura teaches that the invention is used by the population with imperfect skin tone, while applicants argue that the present composition is applied to "age-wrinkled" skin. Applicants assert that the occurrence of the claimed subject matter would occur only by accidents, and the prior art is not anticipated by inherency. However, examiner views that it cannot be said that the users of the Kimura invention is restricted to youths or specific age group, nor is it more likely that those users do not have aged skin than youthful skin. The proposed amendment would nonetheless require further search and consideration to determine if any objective evidence which would support the examiner's and/or applicants' positions are available.

Continuation from No. 5:

Applicants' arguments have been considered but does not place the application in an allowable condition because the amendment is not entered for above reason, and also because the arguments are not persuasive. Applicants argument that Example 13 contains 58.8 wt % of inorganic powders has been considered. However, examiner views that the rejections should be maintained because the Kimura reference also teaches in col. 6, lines 54 - 67 that "not less

Art Unit: 1617

than 10 % by weight” of coherent materials is compounded with respect to the whole powder amount in the composition. The reference teaches using mica coated with titanium dioxide, mica coated with zirconium oxide, plate-like titanium oxide, etc. While applicants assert that the pigments referred in this passage are “interference pigments”, applicants’ argument is not convincing because these “coherent materials” meet the limitation of applicants’ inorganic, nonmatte, non-spherical powder. Examiner also notes that it is held that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. It is well known in patent law that “the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” See MPEP § 2123, quoting *In re Heck*, (citation omitted). *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 U.S.P.Q. 2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). In this case, the Kimura invention is not limited to using the powdery foundation only. See Kimura, Claim 1.

In response to applicants’ assertion that Hineno invention of method of covering wrinkles is limited to loose powder or creams, examiner respectfully notes that the present invention is not limited to using any particularly form of composition, and that the reference specifically teaches the effect of covering wrinkle is provided by “the function of the interference color”. See col. 16, lines 25 – 31.

Art Unit: 1617

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner

  
RUSSELL TRAVERS  
PRIMARY EXAMINER